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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,522	06/04/2001	Richard E. Scordato	M1005/7006 RJK	3542
26453	7590	01/06/2005	EXAMINER	
BAKER & MCKENZIE			GORDON, BRIAN R	
805 THIRD AVENUE			ART UNIT	
NEW YORK, NY 10022			PAPER NUMBER	

1743

DATE MAILED: 01/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/873,522	<b>Applicant(s)</b> SCORDATO ET AL.	
	<b>Examiner</b> Brian R. Gordon	<b>Art Unit</b> 1743	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 5-28-04.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 12-77 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-29 and 33-37 is/are allowed.
- 6) ☒ Claim(s) 1-5, 12, 13, 15-18, 21-24, 30-32, 38-41, 45, 46, 48-50, 54-61, 65, 66, 68-70 and 74-77 is/are rejected.
- 7) ☒ Claim(s) 6-8, 14, 19, 20, 42-44, 47, 51-53, 62-64, 67 and 71-73 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 16 September 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 28, 2004 has been entered.

### ***Response to Arguments***

Applicant's arguments filed March 29, 2004 have been fully considered but they are not persuasive. In view of applicant's amendment/remarks the previous rejection of as based upon Bilbrey et al. is hereby withdrawn.

As to the references of Chi and Rogers applicant also asserts neither reference teaches "a body portion having a vertical central axis longer than a horizontal central axis and shaped to fit in an operator's hand...and at least one button located on the top of the body portion and operable by a thumb of the operator to effect aspiration and dispensing of fluid through said nozzle portion." The examiner respectfully disagrees as illustrated below both devices of Chi and Rogers have a long central vertical axis to which a button is proximate, and a horizontal axis that is shorter than the vertical axis. The phrase "shaped to fit in an operator's hand" is does not add any further structure than the preamble stating "handheld" both phrases simply imply the device is capable of

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being held in a person's hand. Neither phrase requires any particular configuration or shape. The phrase "operable by a thumb" does not further limit the structure of the button. The phrase is directed to intended use of the device. Applicant intends for the device to be held in one's hand and the button be pressed by one's thumb. However, there is nothing preventing applicant's invention or any other hand-held pipette from being held as one desires and the button being pressed by whatever finger the operator so desires to uses.

As to the "nozzle portion extending from a point on said body portion at a downward angle", such language is not interpreted as being limited to a nozzle which is angled from a defined point on the body. In other words the language does not exclude a nozzle from extending from a point on the body and downward as that of Chi and Rogers.

Claim 30 is actually broader than claim 1 for it does not require the specific angle range of the downward facing nozzle. The claim merely recites phrases directed to how applicant intends for the device to held, positioned, and used. As stated above the intended use, process of using the device, and position which applicant intends for the device to be held does not further structurally limit the device. Claim 31 is also broader and contains the same type of phrases as stated above relative to claim 30. Claim 30 appears to moreso directed to a process of using the device in combination with a tip. The structural requirements of claim 30 and 31 are the same. As such, the claims are considered redundant and duplicate claims.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from

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a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

For reasons given herein above the previous rejections as based upon Chi and Rogers are hereby maintained.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 4-5, 12-13, 15-18, 21-24, and 30-31, 40, 45-46, 48-50, 54-58, 60-61, 65-66, 68-70, 74-77 rejected under 35 U.S.C. 102(b) as being anticipated Chi, Des 221,791

Chi discloses a dispenser that appears to be designed with an actuator button aligned with the central vertical axis of the dispenser. The dispenser also comprises a nozzle that extends from a point on the body of the dispenser and the nozzle appears to be at angle between 60 and 80 degrees relative to the axis. The device also comprises a stable base.

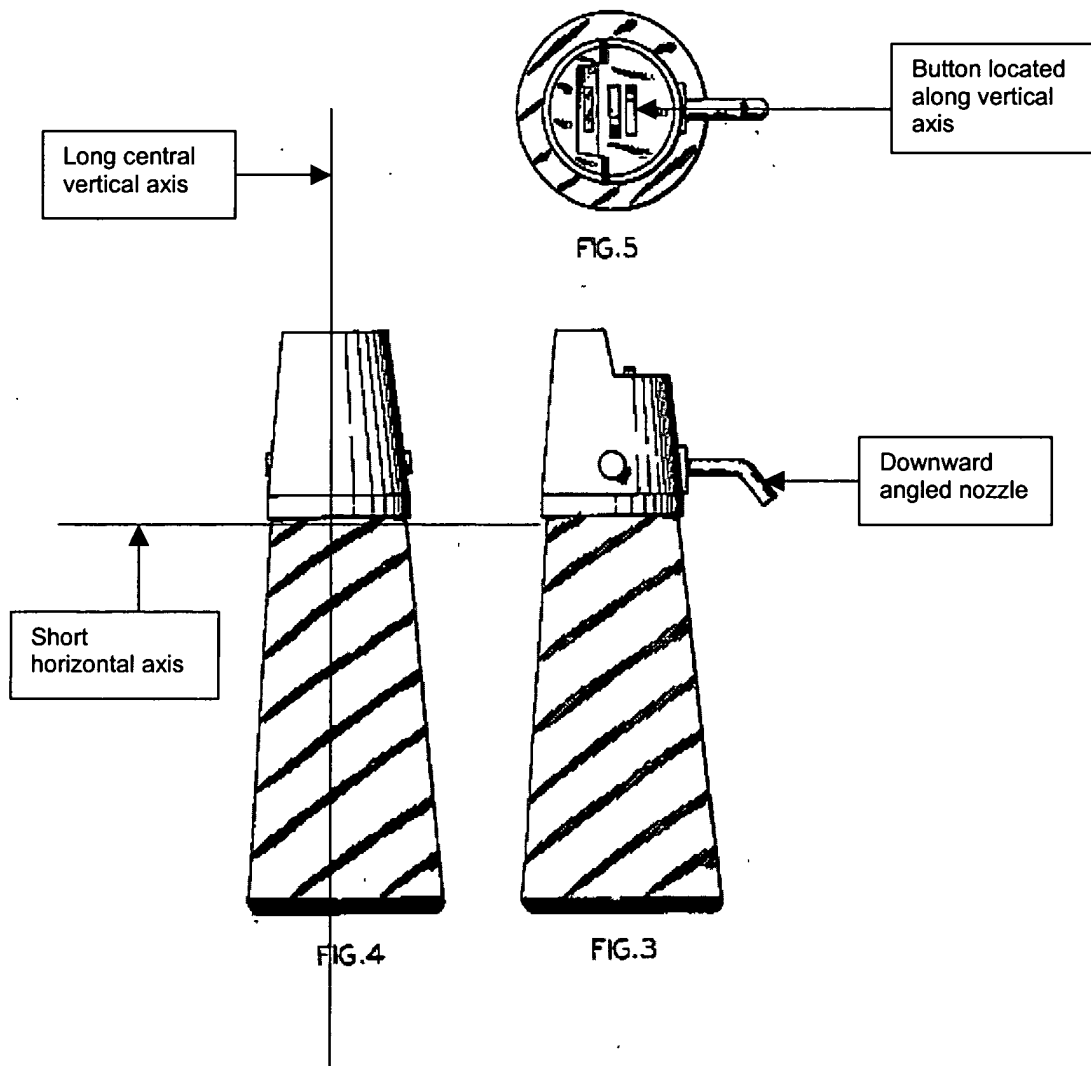
As to the “nozzle portion extending from a point on said body portion at a downward angle”, such language is not interpreted as being limited to a nozzle which is angled from a defined point on the body. In other words the language does not exclude a nozzle from extending from a point on the body and downward as that of Chi.

Furthermore the only structural requirement of the body is that it have the axes

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as claimed. It does not specify and boundaries to where the body is excluded from having the configuration of Chi. Therefore, one may interpreted all of the portions of the element the body except for the point where the downward angle begins.

As to the angle at which the device is held or how the device is held, the operator is allowed to hold the device at any angle to suit his/her personal use or desire. The angle at which the device is held does not limit the use of the device.



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3. Claims 1-5, 12-13, 15-18, 21-24, and 30-32, 38-41, 45-46, 48-50, 54-61, 65-66, 68-70, 74-77 rejected under 35 U.S.C. 102(b) as being anticipated by Rodgers US 4,475,666.

Rodgers discloses an extinguisher tank 10 provided with a head assembly 11 including an operating lever 12 (actuator button aligned with the central vertical axis) and outlet hose 13 (nozzle that extends from a point on the body and may be adjusted to any desired angle) . As shown, there is provided a cartridge 14 receivable in a bottom exterior entrance opening 15 and cooperating elongated receiving tube 16 extending upwardly into the tank 10. The device also comprises a stable base.

As to the “nozzle portion extending from a point on said body portion at a downward angle”, such language is not interpreted as being limited to a nozzle which is angled from a defined point on the body. In other words the language does not exclude a nozzle from extending from a point on the body and downward as that of the flexible hose taught by Rodgers.

As to the angle at which the device is held or how the device is held, the operator is allowed to hold the device at any angle to suit his/her personal use or desire. The angle at which the device is held does not limit the use of the device.

#### ***Allowable Subject Matter***

4. Claims 25-29, 33-37 are allowed.

5. Claims 6-8, 14, 19-20, 42-44, 47, 51-53, 62-64, 67, and 71-73 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in

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independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not teach nor fairly suggest a hook extending from a point on said body portion which is sufficiently angularly spaced from the point from which said nozzle extends to permit the hook to fit over a selected portion of the operator's hand when the pipette is being held by the operator in a position for use, an adapter selectively mountable to said body portion, said adapter adjusting the size of said body portion to better fit operator hand size, and a padding on at least a portion of said body portion.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, with 2nd and 4th F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

brg

A handwritten signature in black ink, appearing to read "B. Z. M.", located below the typed name "brg".